

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: Ned Hoffman Conf. No.: 4850
Serial No. 09/639,948 Examiner: Christina E. Zelaskiewicz
Filed: August 17, 2000 Group Art Unit: 3621
For: SYSTEM AND METHOD FOR TOKENLESS BIOMETRIC
AUTHORIZATION OF ELECTRONIC COMMUNICATIONS

Confirmation No. 4850

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Restriction Requirement dated June 9, 2009, the Applicant provisionally elects to prosecute Group II, claims 32-48, 50-56, 58-63, 65, and 67-68, with traverse.

The Examiner argues that the claims of Group I are “drawn to secure transactions”, and that the claims of Group II are “drawn to business processing using cryptography”. Further, the Examiner believes that the inventions do not overlap in scope and that there would be serious burden to search and examine the claims of both groups in one application. The Applicant respectfully disagrees.

First, no pending claims mention either “secure transactions” or “cryptography”. Both claim groups refer to “tokenless biometric authorization of an electronic communication”. Thus, the Applicant believes the claims of the two Groups are directed to the same invention.


Second, the claims of both groups recite “a user-customized rule module”. The differences between the claims that the Examiner focuses on (that the claims of Group I involve a user preference designation step, whereas the claims of Group II involve an electronic consumer loyalty or rewards incentive) relate to the use of the rule module. But as the differences between the claims are sufficiently narrow to the use of the rule modules, the

Applicant believes the claims of both groups can be searched and examined together without imposing a burden on the Examiner.

Further, even if the inventions of Groups I and II are distinct, the Applicant still believes the claims should be examined together. According to M.P.E.P. § 803, “[i]f the search and examination of all the claims in an application can be made without *serious* burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions” (emphasis added). That the M.P.E.P. refers to “serious burden”, rather than just “burden”, suggests that it is not enough that the Examiner might have to perform different searches for the different inventions. After all, having to search multiple classes/subclasses is by definition more burdensome than searching a single class/subclass, and so the M.P.E.P. would not need to refer to the Examiner’s burden at all. The Applicant believes that searches of prior art in both groups would identify at least overlapping, if not identical, prior art. Given the narrow differences between the claimed inventions of the two Groups, the Applicant believes the Examiner would not be seriously burdened and should examine both claim groups, and the Applicant respectfully requests that the Examiner withdraw the Restriction Requirement.

Respectfully submitted,

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